

**REMARKS**

The Applicant thanks the Examiner for the consideration given the present application. Claims 2, 10, 13, and 15 were previously cancelled. Claims 1, 3-9, 11, 12, 14, and 16-22 are pending. Claims 1 and 19 are amended, and claims 21 and 22 are added. Claims 1 and 19 are independent. The Examiner is respectfully requested to reconsider the rejections in view of the amendments and remarks set forth herein.

**Reasons for Entry of Amendments**

At the outset, it is respectfully requested that this Amendment be entered into the Official File in view of the fact that the amendments to the claims automatically place the application in condition for allowance.

In the alternative, if the Examiner does not agree that this application is in condition for allowance, it is respectfully requested that this Amendment be entered for the purpose of appeal. This Amendment was not presented at an earlier date in view of the fact that Applicants did not fully appreciate the Examiner's position until the Final Office Action was reviewed.

**Examiner Interview**

The Applicant wishes to thank Examiner Emily Morgan for the courtesies extended to Applicant's Representative, Carl T. Thomsen, Registration No. 50,786, during the telephone interview which was conducted on January 6, 2010.

During the interview, the Examiner summarily dismissed without explanation arguments expressed by the Applicant's Representative that the rejections made in the Office Action dated

October 27, 2009 were not proper and should be withdrawn. No agreement was reached between the Examiner and the Applicant's Representative in this regard.

However, during the interview, the Examiner stated, that in her opinion, the suspensions spring (9) connecting one end of the suspension arm (7) to the mounting leg (2) of the present invention was not taught or suggested by the Rison and Barnard references cited in the Office Action dated October 27, 2009. This suggestion was much appreciated. By way of this Amendment, the claims have been amended in the manner discussed during the interview, and are believed to place the application into condition for allowance. Accordingly, reconsideration and allowance of the present application are respectfully requested.

If, during further examination of the present application, a discussion with the Applicant's Representative would advance the prosecution of the present application, the Examiner is encouraged to contact Carl T. Thomsen, Registration No. 50,786, at 1-703-208-4030 (direct line) at her convenience.

#### **Objection to the Claims**

In response to the Examiner objection, each of independent claims 1 and 19 has been amended to correct the typographical error in the claims previously presented. The term "contact section" has now been replaced by "contacting section." As such, the Applicant has overcome the Examiner's objection.

**Objection to the Drawings**

As discussed above, the “contact section” has been cancelled from the claims. As such, the Applicant has overcome the Examiner’s objection.

**Restriction Requirement**

The Examiner has made the Restriction Requirement final, and has withdrawn claims 3-9, 11, 12, 14, and 17 from further consideration. Withdrawn claims 3-9, 11, 12, 14 and 17 remain pending.

When independent claim 1 is found to be allowable, the Applicant requests that the Examiner rejoin and consider each of the dependent claims.

**Rejections Under 35 U.S.C. §103(a)**

Claims 1, 16, and 18-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rison (U.S. 1,066,754) in view of Barnard (U.S. 4,752,105). This rejection is respectfully traversed.

**Amendments to Independent Claims 1 and 19**

While not conceding the appropriateness of the Examiner’s rejection, but merely to advance prosecution of the present application, **independent claim 1** has been amended herein to recite a combination of elements directed to a caster, including *inter alia*

“a single mounting leg;

first and second wheels each having an axle pivotably mounted to opposite ends of a suspension arm, the axle of one of the first and second wheel coaxially supporting the

suspension arm to the mounting leg in a manner such that only the other of the first and second wheels is movable up and down with respect to the mounting leg.”

In addition, **independent claim 19** has been amended herein to recite a combination of elements directed to a caster, including *inter alia*

“a mounting leg;

first and second wheels each having an axle pivotably mounted to first and second ends of a suspension arm, the axle of first wheel coaxially supporting the first end of the suspension arm to the mounting leg;

a suspension spring connecting the second end of the suspension arm to the mounting leg and enabling the second wheel to move up and down with respect to the mounting leg.”

Support for the novel features of **independent claims 1 and 19** can be seen, for example, in FIGS. 1-7.

The Applicant respectfully submits that the combination of elements set forth in each of **independent claims 1 and 19** is not disclosed or made obvious by the applied prior art of record, including Rison and Barnard.

**Regarding the Rison Reference**

The Examiner concedes that Rison fails to disclose the structure of the wraparound member as set forth in each of **independent claims 1 and 19**.

In addition, in contrast to **independent claims 1 and 19**, Rison merely discloses wheels 19 and 21, neither of which is movable in an up and down direction with respect to

the frame 11. Rison fails to disclose either the claimed suspension arm (7) or the suspension spring (9).

In addition, the mere fact that Rison wheel 19 has a groove 20 does not change the fact that wheel 19 and wheel 21 of Rison are not offset with respect to each other in the axial direction of the wheels, as set forth in independent claim 19 and dependent claim 21.

If the Examiner continues to insist that her conclusion that wheel 19 and wheel 21 of Rison are offset with respect to each other in the axial direction of the wheels, she is respectfully request to show specific evidence to support her position.

**Regarding the Barnard Reference**

The deficiencies of Barnard include the following:

**1. Deficiency #1**

Barnard fails to disclose wheels only one of which is movable in an up and down direction with respect to the frame 30. In addition, Barnard fails to disclose either the presently claimed suspension arm (7) or the suspension spring (9).

**2. Deficiency #2**

On page 4-5 and page 9 of the Office Action, the Examiner asserts that

“each of the spaced friction faces (12.1) (Fig. 3) having a face (39) (Fig. 8) extending in an axial direction of the wheels (Fig. 8) and facing the track element (40) of either side thereof” of Barnard discloses

“each of the wheel guide sections (27) having a connecting section (29) extending in an axial direction of the wheels (3, 4) and facing the adjacent pieces (25) of either side thereof,” as set forth in each of **independent claims 1 and 19** as previously presented.

The Applicant respectfully disagrees.

As can be plainly seen in Barnard Fig. 3, face (39) is merely the face between outer part (40.1) and inner part (40.2) of the same track element (40). The face (39) in each of the track elements (40) of Barnard does not face the adjacent track elements (40) on either side thereof (thereof, meaning “the spaced friction faces (12.1)”).

If the Examiner continues to insist that her conclusion that face (39) between outer part (40.1) and inner part (40.2) of the same track element 40 of Barnard disclose the subject matter of **independent claims 1 and 19**, she is respectfully request to show specific evidence to support her position.

### **3. Deficiency #3**

On page 4-5 and page 9 of the Office Action, the Examiner asserts that

“channel (56) formed on inner and outer peripheral ends of face (39)” of Barnard discloses

“a pair of side walls (28, 28) formed, respectively, on inner and outer peripheral ends of the connecting section (29)” as set forth in each of **independent claims 1 and 19**.

The Applicant respectfully disagrees.

As can be seen in Barnard Fig. 5, channel (56) is a single U-shaped channel which extends along the entire axial length of pad (60). Moreover, channel (56) is far removed from

face (39), and certainly is not formed on inner and outer peripheral ends of face (39) as the Examiner alleges.

If the Examiner continues to insist that her conclusion that “channel (56) formed on inner and outer peripheral ends of face (39)” of Barnard discloses the subject matter of **independent claims 1 and 19**, she is respectfully request to show specific evidence to support her position.

**4. Deficiency #4**

On page 5 and page 9 of the Office Action, the Examiner asserts that

“central locating ridge (12.2)” formed in the center of “channel part (46)” of Barnard discloses

“each of the side walls (28) formed on inner and outer peripheral ends of the connecting section (29) including a guide wall (30, 30),” as set forth in each of **independent claims 1 and 19**.

The Applicant respectfully disagrees.

As can be seen in Barnard Fig. 3, only one “central locating ridge (12.2)” is formed on each “track member (12).” Moreover, “central locating ridge (12.2)” is far removed from “face (39)”, and certainly is not formed on inner and outer peripheral ends of face (39) as the Examiner alleges.

The Examiner argues that the two guide walls (30, 30) of **independent claims 1 and 19** would be obvious over Barnard as being a mere duplication of essential working parts. However, neither of the guide walls (30, 30) formed on inner and outer peripheral ends of the

connecting section (29) is a duplicate of the single “central locating ridge (12.2)” is formed on each “track member (12),” as disclosed in Barnard.

On page 6 of the Office Action, the Examiner states “Placing such a guide wall on either side of the track piece to one wheel on each side would provide another layer of insurance that the track will stay in it proper place.” While this may be the case, the Applicant submits that the Examiner has resorted to mere hindsight.

If the Examiner continues to insist that her conclusion that a single “central locating ridge (12.2)” formed in the center of “channel part (46)” of Barnard, discloses the subject matter of **independent claims 1 and 19**, she is respectfully request to show specific evidence to support her position.

#### **5. Inherency Test Not Met**

As the Examiner knows well, a prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is **inherent**, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).



As discussed under the heading numbers 1-5 above, the Applicant respectfully submits that Barnard fails to disclose the subject matter set forth in **independent claims 1 and 19**, and also fails to make up for the deficiency of Rison.

At least for the reasons explained above, the Applicant respectfully submits that the combination of elements as set forth in each of **independent claims 1 and 19** is not disclosed or made obvious by the prior art of record, including Rison and Barnard.

### **Dependent Claims**

**Dependent claims 16, 18, and 20** as previously presented are in condition for allowance due to their dependency from allowable independent claims, and/or due to the additional novel features set forth therein.

**Dependent claim 16** recites “the at least one connecting member is a sheet belt.”

**Dependent claim 18** recites “the at least one connecting member is a cord extending through a connecting hole provided in each of the side walls.”

**Dependent claim 20** recites “wherein portions of the first wheel and the second wheel overlap each other when viewed in the axial direction of the wheels.”

The Applicant submits that the Examiner has resorted to hindsight in her rejection of each of **dependent claims 16, 18, and 20**.

In the rejection of **dependent claim 18**, the Examiner refers to *In re Japikse*, and alleges that the Barnard “wire (41) extending through a connecting hole (43)” involves a mere

rearrangement of parts. The Examiner ignores that fact that neither Rison nor Barnard discloses “a pair of side walls (28, 28),” as disclosed in **dependent claim 18**.

In the rejection of **dependent claim 20**, the Examiner refers to *In re Japikse*, and alleges that the wheels (19, 21) of Rison and wheels (14, 16) of Barnard can be rearranged to disclose “portions of the first wheel (3) and the second wheel (4) overlap each other when viewed in the axial direction of the wheels (3, 4),” as set forth in **dependent claim 20**. The Examiner ignores that fact that Rison merely discloses “wheels for a caster for a piece of furniture” and Barnard merely discloses “wheels for an engine powered tractor,” and that Rison and Barnard are non-analogous.

Moreover, the Applicant submits that regardless of how any of the wheels (3, 4, 19, and 21) of Rison and Barnard are rearranged on axles of Barnard and/or on the axles (17, 18) of Rison, none of wheels (3, 4, 19, and 21) would overlap any other one of the wheels.

If either or both of wheels (19, 21) were substituted for one or both of the wheels (14, 16) of Barnard, they would not overlap each other when view in the axial direction. In addition, neither one of the axles (17, 18) of the Rison castor can accommodate either of the engine powered tractor wheel (14, 16) of Barnard. The Examiner’s attempt to combine these two non-analogous references to reject claim 20 is not proper

Moreover, the Applicant submits that the Examiner has failed to meet the Inherency Test as described above.

No combination of Rison and Barnard provides any disclosure of  
“the at least one connecting member is a sheet belt” (claim 16), or

the at least one connecting member is a cord extending through a connecting hole provided in each of the side walls” (claim 18), or

“portions of the first wheel and the second wheel overlap each other when viewed in the axial direction of the wheels” (claim 20).

All pending claims are now in condition for allowance.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

**CONCLUSION**

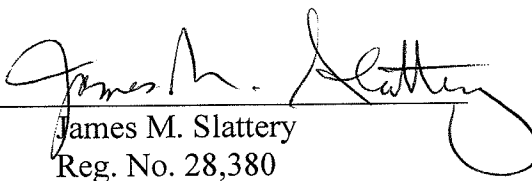
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. It is believed that a full and complete response has been made to the outstanding Office Action, and that the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, she is invited to telephone Carl T. Thomsen (Reg. No. 50,786) at (703) 208-4030 (direct line).

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly extension of time fees.

Respectfully submitted,

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